

REMARKSOverview

The Examiner responded in the prior Office Action as follows: rejected claims 1-7, 9-12, 14-22 and 67-69 under 35 U.S.C. § 102(e) as being anticipated by Wang Baldonado et al. (U.S. Patent Application Publication No. 2002/0147880A1); rejected claims 61-66 under 35 U.S.C. § 102(e) as being anticipated by Abbott et al. (U.S. Patent No. 6,549,915B2); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Wang Baldonado in view of Kravets (U.S. Patent No. 6,363,377B1); rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Wang Baldonado in view of Sharp (U.S. Patent No. 6,263,317B1); rejected claims 23-35 under 35 U.S.C. § 103(a) as being unpatentable over Wolfe (U.S. Patent No. 6,282,517B1) in view of Colosso (U.S. Patent No. 6,169,976B1); and rejected claims 36-44 under 35 U.S.C. § 103(a) as being unpatentable over Wolfe in view of Pirolli (U.S. Patent No. 6,272,507B1).

Applicants hereby amend claims 61 and 62 in order to correct minor typographical errors, and amend claim 63 to rewrite it in independent form. Applicants further hereby cancel claims 1-60 and 67-69, and add claims 70-132. Thus, claims 61-66 and 70-132 are now pending.

Discussion


The Examiner has rejected each of the previously pending claims 61-66 under 35 U.S.C. § 102(e) as being anticipated by Abbott (U.S. Patent No. 6,549,915B2). However, this rejection is improper, as Abbott does not qualify as prior art as discussed below. Since this was the only basis of rejection for claims 61-66, these claims are in allowable form, as are new claims 70-109 that depend from these claims. Similarly, new independent method and computer-readable medium claims 110 and 132 each recite similar claim elements to those of claim 61, and thus claims 110-132 are allowable for at least the same reasons as claim 61. Moreover, while Applicants disagree that the other cited prior art anticipates or renders obvious any of the previously pending claims 1-60 and 67-69, Applicants have canceled those claims in

order to expedite prosecution. Thus, all of the currently pending claims are allowable over the Examiner's previously indicated bases for rejection, and Applicants therefore respectfully request that the Examiner timely indicate allowance of all pending claims.

As noted above, the Abbott patent does not qualify as prior art, and thus cannot be used as a basis for rejecting any of the claims of the current application. In particular, the issue date of the Abbott patent is April 15, 2003, and the prior publication data for the Abbott patent indicates a date of March 14, 2002. Since the current application was filed in April of 2001 (and claimed priority to a provisional patent application filed in April of 2000), Abbott would qualify as prior art to the current application only under 35 U.S.C. § 102(e). However, 35 U.S.C. § 103(c) makes clear that "[s]ubject matter . . . which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person". Since the invention described in the current application and the Abbott patent were both subject to an obligation of assignment to Tangis Corporation at the time the invention was made, the Abbott patent is not prior art under 35 U.S.C. § 102(e). Moreover, as a further reason that the Abbott patent is not prior art under 35 U.S.C. § 102(e) to the current patent application, the provisions of 35 U.S.C. § 102(e) apply only to patents and patent applications "by another" – since the inventive entity of the current application and the Abbott patent are the same, this is a further reason that the Abbott patent is not prior art to the current application. Please see MPEP 706.02(f) for additional details.

In light of the above remarks, Applicants respectfully submit that all of the pending claims are allowable. Applicants therefore respectfully request that the Examiner timely allow all pending claims. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 264-6380.

Respectfully submitted,  
Perkins Cole LLP

  
James A. D. White  
Registration No. 43,985

JDW:

Enclosures:  
Postcard  
Form PTO-1083 (+ copy)  
Petition for an Extension of Time (+ 2 copies)

1201 Third Avenue, Suite 4800  
Seattle, Washington 98101-3099  
(206) 583-8888  
Fax: (206) 583-8500